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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/921,654
Filing Date: August 03, 2001
Appellant(s): AMAR ET AL.

Joseph A. Capraro, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 4, 2008 appealing from the Office action mailed March 12, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

Furthermore, the following New Grounds of rejection has been included:

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

Furthermore, the following New Grounds of rejection has been added.

Claim Rejections - 35 USC § 112, Second Paragraph

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites limitations in “means plus function” language. The scope of a “means” limitation is defined as the corresponding structure or material set forth in the written description and equivalents thereof. See MPEP § 2181 through § 2186. If there is no disclosure of structure, material or acts for performing the recited function in the specification, the claim limitation lacks specificity, and fails to satisfy the requirements of 35 U.S.C. 112, second paragraph.

Recent court cases have held that simply reciting “software” without providing some detail about the means to accomplish the function is not enough. *See Aristocrat Techs. Austl. Pty v. Int’l Game Tech.*, ___ F.3d ___, 2008 U.S. App. LEXIS 6472, at *10 [[86 USPQ2d 1235](#)] (Fed. Cir. Mar. 28, 2008) (“For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to ‘the corresponding structure, material, or acts’ that perform the function, as required by

section 112 paragraph 6.”). The Court in *Aristocrat* did not require a listing of source code or a highly detailed description of the algorithm to be used to achieve the claimed functions in order to satisfy 35 U.S.C. §112 paragraph 6. It did require, however, the disclosure of at least the algorithm that transformed the general purpose microprocessor to a “special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming*, 184 F.3d at 1349. Thus the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm or description of structure corresponding to the claimed function to provide the necessary structure under 35 U.S.C. §112 paragraph 6.

In the instant case, the “means plus function” language recited in claim 20, in limitations (a), (e), (f), (g), (h), (i), (j), (k), lacks sufficient disclosed structure under 112, sixth paragraph, and is therefore indefinite under 112, second paragraph.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

- | | | |
|-------------------|-----------------|---------|
| 1. 6, 453, 297 B1 | Burks et al. | 09-2002 |
| 2. 6, 047, 259 A | Campbell et al. | 04-2000 |

3. 5, 253, 164 A	Holloway et al.	10-1993
4. 5, 995, 939 A	Berman et al.	11-1999
5. 6, 757, 898 B1	Ilsen et al.	06-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(New Grounds) Claim Rejections - 35 USC § 112, Second Paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites limitations in “means plus function” language. The scope of a “means” limitation is defined as the corresponding structure or material set forth in the written description and equivalents thereof. See MPEP § 2181 through § 2186. If there is no disclosure of structure, material or acts for performing the recited function in the specification, the claim limitation lacks specificity, and fails to satisfy the requirements of 35 U.S.C. 112, second paragraph.

Recent court cases have held that simply reciting “software” without providing some detail about the means to accomplish the function is not enough. *See Aristocrat Techs. Austl. Pty*

v. Int'l Game Tech., ___ F.3d ___, 2008 U.S. App. LEXIS 6472, at *10 [86 USPQ2d 1235] (Fed. Cir. Mar. 28, 2008) (“For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to ‘the corresponding structure, material, or acts’ that perform the function, as required by section 112 paragraph 6.”). The Court in *Aristocrat* did not require a listing of source code or a highly detailed description of the algorithm to be used to achieve the claimed functions in order to satisfy 35 U.S.C. §112 paragraph 6. It did require, however, the disclosure of at least the algorithm that transformed the general purpose microprocessor to a “special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming*, 184 F.3d at 1349. Thus the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm or description of structure corresponding to the claimed function to provide the necessary structure under 35 U.S.C. §112 paragraph 6.

In the instant case, the “means plus function” language recited in claim 20, in limitations (a), (c), (f), (g), (h), (i), (j), (k), lacks sufficient disclosed structure under 112, sixth paragraph, and is therefore indefinite under 112, second paragraph.

Claim Rejections - 35 USC § 112, First Paragraph

NOTE: The rejections of claims 1, 15, 20, 27, 28 under 35 U.S.C. § 112, first paragraph are hereby withdrawn in light of Applicant's arguments given at pages 20-24 of the Appeal Brief (Section VII, paragraph A).

Claim Rejections - 35 USC § 103

Claims 1-6, 9-16, 18-20, 24-28, 30-33 are rejected under 35 U.S.C. 103(a).

These rejections are set forth in prior Office Action, Paper No 20080221 and reproduced hereinbelow. The rejections that appear below substantially repeat the rejections made in the previous Office Action (Paper Number 20080221). The text of those sections of Title 35 U.S. Code relied upon in the Examiner's Answer is set forth in the previous Office action, Paper Number 20080221.

5. Claims 1-6, 13-16, 18-20, 24-28, 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burks et al., U.S. Patent Number 6, 453, 297 and Campbell et al., U.S. Patent Number 6, 047, 259, in view of Holloway et al., U.S. Patent Number 5, 253, 164.

(A) As per claim 1, Burks teaches a method for managing a medical practice comprising:

(a) storing one or more insurance rules in an insurance company rules database on a medical practice management server (Burks; Figure 1, Items 10, 12, column 3, lines 24-32, column 4, lines 16-24, column 6, lines 9-29, column 7, line 55 to column 8, line 46);

(b) communicating with a medical practice client user interface over a first communication network (Burks; column 3, lines 9-15, column 6, lines 58-60);

(c) communicating with a payor server over a second communications network (Burks; column 3, lines 33-36, column 6, lines 3-8);

(d) receiving information associated with an event related to a patient from at least one of the medical practice client user interface or the payor server (Burks; column 6, lines 8-19);

(f) performing, by the medical practice management server, one or more workflow tasks in a billing workflow (Burks; column 4, lines 11-25), which creates, “verifies” (reads on “examines”) (Burks; column 3, line 65 to column 4, line 1) and “reorganizes” (reads on “processes”) (Burks; column 5, lines 51-54) an insurance claim, associated with the event (Burks; column 7, line 55 to column 8, line 46); Examiner interprets Burks’s teachings of “[t]hese generic data records include ... [...] ... financial information” (Burks; column 7, lines 64-67) be a form of “in a billing workflow”);

(h) using at least a portion of the information, which is defined by one or more insurance rules in the insurance company rules database (Burks; column 3, lines 59-61) that apply to the payor server, associated with the event and used to create the insurance claim, which is formatted according to the one or more insurance rules that apply to the payor server, following completion of the one or more tasks (Burks; Figure 1, Items 10, 12, column 3, lines 31-32, column 6, lines 9-29, column 7, line 55 to column 8, line 46); Examiner interprets Burks’s teachings of “[a]nother advantage of such a system 18 is that the information passing through the system can be organized in generic data records independent of the data message formats which

are being received by and transmitted from the medical transaction system. These generic data records include claim information, financial information, and medical history information” (emphasis added) (Burks; 7, lines 59-65) together with Burks’s teachings of “communications transmitter for transmitting the formatted message information to a trading partner in a communication protocol and data message format recognized by the trading partner [reads on “formatted according to the ... [...] ... rules that apply to the payor server”]” (Burks; column 3, lines 31-62) and Burks teachings of “[t]he medical transaction system of FIG. 3 is capable of communicating with a variety of data message formats and communication protocols. Such a system is capable of remedying an ill recently noted by the President of the United States that there is complete lack of a uniform medical claim in the United States. A system incorporating the present invention provides uniformity without imposing the costs of requiring the insurance carriers and the healthcare providers to use the same data format” (Burks; column 8, lines 5-13) together with Burks’s teachings of “[t]he medical transaction systems shown in FIGS. 1 through 3 are preferably performed by software executing on a ... [...] ... computer ... [...] ... and operating system ... [...] ... include custom written software programs ... [...] ... [reads on “rules that apply to the payor server”] ... [...] ... executes on a single computer running a single operating system, the communication function could be segregated in one computer system that handles the communication protocol processing for the reception and transmission of data messages. After the ... [...] ... processing is completed, the communication computer could then transfer the data messages to another computer system executing a compiler program to compile information from the data messages and create the generic records, and an extractor

program could extract selected ones of the generic records, format them to particular data formats and provide the formatted data messages to the communication computer for transmission to a healthcare provider or trading partner [reads on “payor”] computer station” (Burks; column 8, lines 19-46) to teach this limitation; and

(i) submitting the insurance claim to the “trading partner” (reads on “payor”) server (Burks; column 3, line 60 to column 4, line 6).

Although Burks teaches performing one or more tasks associated with the event (Burks; column 6, lines 15-19), and automatically and repeatedly interacting with the information associated with the event by applying one or more rules within a set of rules and performing transactions with the “trading partner” (reads on “payor”) server (Burks; column 3, line 60 to column 4, line 6), Burks fails to explicitly disclose

(e) performing by the medical practice management server one or more workflow tasks in a patient workflow associated with the event;

(g) automatically and repeatedly interacting with the information associated with the event during the patient workflow tasks and billing workflow tasks to correct an error, a deficiency, or any combination thereof by applying one or more rules within a set of rules in a rules engine.

However, the above features are well-known in the art, as evidenced by Campbell.

In particular, Campbell teaches

(e) performing by the medical practice management server (Campbell; Figure 2, Item 202) one or more workflow tasks in a patient workflow associated with the event (Campbell; column 3, lines 54-59, column 5, lines 32-67, column 6, lines 22-55, column 9, lines 5-15);

(g) automatically and repeatedly interacting with the information associated with the event during the patient workflow tasks and billing workflow tasks to correct an error, a deficiency, or any combination thereof (Campbell; column 2, lines 31-37, column 15, lines 48-51, column 18, lines 10-16, 27-43) by applying one or more rules within a set of rules in a rules engine; Examiner interprets Campbell's teachings of "[t]he server automatically adds service items completed during the visit to the client's invoice" (Campbell; column 15, lines 48-51) to be a form of correcting a deficiency during a billing workflow task by applying one or more rules within a set of rules in a rules engine and Campbell's teachings of "[t]he server removes the diagnosis from the rule out list, adds it to the tentative diagnosis, and determines which abnormal observations are linked to the diagnosis" (Campbell; column 17, lines 10-12) to be a form of correcting a deficiency during a patient workflow task by applying one or more rules within a set of rules in a rules engine.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Burks to include these limitations, as taught by Campbell, with the motivations of providing a graphical and interactive medical office management system that effectively manages workflow, automatically generates client education information, tracks the conducting of a physical examination, diagnosing of medical conditions and management of

a therapy protocol, and tracks the flow of patients in a medical office (Campbell; Abstract, column 1, lines 35-37).

Burks and Campbell fail to explicitly disclose

(j) automatically and repeatedly interacting with the insurance claim to correct an error by applying a new rule, an updated rule, or both received from the payor server; and

(k) automatically and repeatedly updating the one or more insurance rules in the insurance company rules database that apply to the payor server by applying the new rule, the updated rule, or both received from the payor server.

However, the above features are well-known in the art, as evidenced by Holloway.

In particular, Holloway teaches

(j) automatically and repeatedly interacting with the insurance claim to correct an error by applying a new rule, an updated rule, or both received from the payor server (Holloway; column 3, lines 16-67); and

(k) automatically and repeatedly updating the one or more insurance rules in the insurance company rules database that apply to the payor server by applying the new rule, the updated rule, or both received from the payor server (Holloway; column 3, lines 30-36, column 4, line 67 to column 5, line 3, column 10, lines 51-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Burks and Campbell to include these limitations, as taught by Holloway, with the motivations of providing “a cost effective automated data processing system” that will “detect and correct ... [claims] ... errors” by using “expert systems

as applied to the field of medical claims analysis and decision-making mechanisms for analyzing and applying payments to ... [...] ... medical claims” (Holloway; column 1, lines 11-13, column 2, lines 14-16 column 3, lines 6-13).

(B) As per claims 2-6, Burks, Campbell and Holloway teach a method as analyzed and discussed in claim 1 above

further comprising verifying the information at least one of before, during, or following performing the workflow tasks in the patient workflow associated with the event, or any combination thereof (Burks; column 3, line 65 to column 4, line 4, column 6, lines 37-40), (Campbell; column 9, line 65 to column 10, line 3);

further comprising the steps of:

(l) receiving an error notification (Burks; column 6, lines 49-52); and

(m) performing a correcting action in response thereto (Burks; column 9, lines 45-60);

wherein the performing the correcting action further comprises transmitting an error message denoting an error to the medical practice (Burks; column 6, lines 47-59, column 9, lines 45-49);

wherein the correcting action comprises correcting at least one of a typographical error, a formatting error, and “insufficient” (reads on “incomplete”) information, or any combination thereof (Burks; column 10, lines 44-51); and

further comprising generating the error notification (Burks; column 6, lines 47-51).

The motivations for combining the respective teachings of Burks, Campbell and Holloway are as given in the rejection of claim 1 above, and incorporated herein.

(C) As per claims 13-14, Burks, Campbell and Holloway teach a method as analyzed and discussed in claims 1 and 2 above

wherein the performing of the workflow tasks in the billing workflow following the event further comprises the step of

receiving a claim (Burks; column 5, lines 51-54); and

wherein the transactions performed with the payor server further comprises claim submittals (Burks; column 5, lines 34-36).

(D) Claim 15 differs from amended method claim 1, in that it is a system rather than a method for managing a medical practice.

System claims 15, 18 and 19 repeat the subject matter of claims 1, 2 and 14, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 1, 2 and 14 have been shown to be fully disclosed or obvious by the combined teachings of Burks, Campbell and Holloway in the above rejection of claims 1, 2 and 14, it is readily apparent that the system disclosed by Burks, Campbell and Holloway includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1, 2 and 14, and incorporated herein.

(E) As per claim 16, Burks, Campbell and Holloway teach a system as analyzed and discussed in claim 15 above

further comprising a patient information database (Burks; column 4, lines 29-31) and an insurance information database (Burks; column 3, lines 60-62, column 6, lines 21-29, column 7, lines 40-44).

(F) Claim 20 differs from method claim 1, in that it is a system rather than a method for medical practice management.

System claim 20 repeats the subject matter of claim 1, respectively, as a set of “means-plus-function” elements rather than a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed or obvious by the combined teachings of Burks, Campbell and Holloway in the above rejection of claim 1, it is readily apparent that the system disclosed by Burks, Campbell and Holloway includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

(G) As per claims 24-26, Burks, Campbell and Holloway teach a method as analyzed and discussed in claims 1-2 above,

wherein a portion of the information associated with the event comprises first procedure information and second procedure information (Campbell; column 17, lines 53-57).

wherein the performing of the workflow tasks in the billing workflow following the event further comprise the steps of “setting a flag” (reads on “moving the claim into a claim inquiry group and assigning an additional task to be completed to close the claim”) (Burks; Figure 9, column 9, lines 45-60, column 12, lines 55-57); and

wherein the one or more rules in the set of rules have universal applicability, apply only to one or more specific insurance packages, apply only to specific medical care providers, or any combination thereof (Burks; column 3, line 45 to column 4, line 6, column 5, line 66 to column 6, line 19).

The motivations for combining the respective teachings of Burks, Campbell and Holloway are as given in the rejection of claim 1 above, and incorporated herein.

(H) As per claim 27, Burks, Campbell and Holloway teach a method for managing a medical practice comprising:

(a) storing one or more rules in an insurance company rules database (Burks; Figure 1, Items 10, 12, column 2, lines 59-62, column 3, lines 59-61, column 6, lines 9-29, column 7, line 55 to column 8, line 46);

(b) communicating with a medical practice client user interface over a first communication network (Burks; column 3, lines 9-15);

(c) communicating with a payor server over a second communications network (Burks; column 3, lines 33-36);

(d) receiving information associated with an event related to a patient from at least one of the medical practice client user interface, the payor server, or any combination thereof (Burks; column 6, lines 8-19);

(e) performing one or more workflow tasks in a patient workflow associated with the event (Campbell; column 3, lines 54-59, column 5, lines 32-37, 61-66, column 6, lines 22-45);

(f) performing one or more workflow tasks in a billing workflow (Burks; column 4, lines 11-25), which creates, “verifies,” (reads on “examines”) (Burks; column 3, line 65 to column 4, line 1) and “reorganizes” (reads on “processes”) (Burks; column 5, lines 51-54) an insurance claim, associated with the event (Burks; column 7, line 55 to column 8, line 46); Examiner interprets Burks’s teachings of “[t]hese generic data records include ... [...] ... financial information” (Burks; column 7, lines 64-67) be a form of “in a billing workflow”);

(g) after performance of the one or more workflow tasks in the patient workflow and the one or more workflow tasks in the billing workflow, storing at least a portion of the information associated with the event, which is defined and formatted by the one or more rules in the insurance company rules database (Burks; column 3, lines 59-61) that apply to the payor server, for a purpose other than to create the insurance claim (Burks; Figure 1, Items 10, 12, column 3, lines 31-32, column 6, lines 9-29, column 7, line 55 to column 8, line 46), (Campbell; column 10, lines 47-62); Examiner interprets Burks’s teachings of “[a]nother advantage of such a system 18 is that the information passing through the system can be organized in generic data records independent of the data message formats which are being received by and transmitted from the medical transaction system. These generic data records include claim information, financial information, and medical history information” (emphasis added) (Burks; 7, lines 59-65) together with Burks’s teachings of “communications transmitter for transmitting the formatted message information to a trading partner in a communication protocol and data message format recognized by the trading partner [reads on “formatted according to the ... [...] ... rules that apply to the payor server”]” (Burks; column 3, lines 31-32) together with Burks’s teachings of

“[t]he medical transaction systems shown in FIGS. 1 through 3 are preferably performed by software executing on a ... [...] ... computer ... [...] ... and operating system ... [...] ... include custom written software programs ... [...] ... [reads on “rules that apply to the payor server”] (Burks; column 8, lines 19-46) together with Campbell’s teachings of “[t]he server maintains patient status table storing a dynamic list of all patients which are in the hospital at a given time. This table also includes the date and time the patient arrived, and the current physical location of the patient within the hospital. The server updates the table in response to messages from the clients that change the status of the patient” (Campbell; column 10, lines 47-62) to teach this limitation;

(h) automatically and repeatedly interacting with the information associated with the event in connection with the performed patient workflow and billing workflow tasks by applying one or more rules to correct an error, a deficiency, or any combination thereof (Campbell; column 2, lines 31-37, column 15, lines 48-51, column 18, lines 10-16, 27-43); Examiner interprets Campbell’s teachings of “[t]he server automatically adds service items completed during the visit to the client’s invoice” (Campbell; column 15, lines 48-51) to be a form of correcting a deficiency during a billing workflow task by applying one or more rules and Campbell’s teachings of “[t]he server removes the diagnosis from the rule out list, adds it to the tentative diagnosis, and determines which abnormal observations are linked to the diagnosis” (Campbell; column 17, lines 10-12) to be a form of correcting a deficiency during a patient workflow task by applying one or more rules;

(i) submitting the insurance claim to the “trading partner” (reads on “payor”) server (Burks; column 3, line 60 to column 4, line 6);

(j) automatically and repeatedly interacting with the insurance claim to correct an error by applying a new rule, an updated rule, or both received from the payor server (Holloway; column 3, lines 16-67); and

(k) automatically and repeatedly updating the one or more insurance rules in the insurance company rules database that apply to the payor server by applying the new rule, the updated rule, or both received from the payor server (Holloway; column 3, lines 30-36, column 4, line 67 to column 5, line 3, column 10, lines 51-60).

The motivations for combining the respective teachings of Burks, Campbell and Holloway are as given in the rejection of claim 1 above, and incorporated herein.

(I) Claims 28, 30-33 differ from method claims 1-5 by reciting a “computer program product, tangibly embodied...” in the preamble. As per this limitation, Burks clearly discloses his invention to be implemented on a computer program product (Burks; column 3, lines 9-32). The remainder of claims 28, 30-33 repeat the limitations of claims 1-5, and are therefore rejected for the same reasons given above for claims 1-5.

The motivations for combining the respective teachings of Burks, Campbell and Holloway are as given in the rejection of claim 1 above, and incorporated herein.

6. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burks et al., U.S. Patent Number 6, 453, 297, Campbell et al., U.S. Patent Number 6, 047, 259, and Holloway

et al., U.S. Patent Number 5, 253, 164 as applied to claims 1 and 2 above, and further in view of Berman et al., U.S. Patent Number 5, 995, 939.

(A) As per claim 9, Burks, Campbell and Holloway teach a method as analyzed and discussed in claims 1 and 2 above.

Although Burks, Campbell and Holloway teach performing tasks associated with an event such as a patient visit (Burks; column 6, lines 8-19), Burks, Campbell and Holloway fail to explicitly disclose a method

wherein the performing of the workflow tasks in the patent workflow before the event further comprises the steps of at least one of

receiving a request for an appointment,
searching for the patient in a patient information database,
receiving insurance information,
receiving referral information, and
receiving a proposed schedule appointment, or
any combination thereof.

However, the above features are well-known in the art, as evidenced by Berman.

In particular, Berman teaches

wherein the performing of the workflow tasks in the patent workflow before the event further comprises the step of

receiving referral information (Berman; column 4, lines 7-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Burks and Campbell to include receiving referral information, as taught by Berman, with the motivations of improving efficiency in managing medically-related information by handling referrals and authorizations electronically, resulting in reducing the “endlessly spiraling costs” in the health care industry (Berman; column 1, line 15 to column 2, line 17).

(B) As per claims 10-11, Burks, Campbell, Holloway and Berman teach a method as analyzed and discussed in claims 1, 2 and 9 above.

wherein the receiving insurance information further comprises the steps of parsing or analyzing the insurance information and determining whether the patient is eligible (Berman; column 4, lines 13-14); and

wherein the receiving referral information further comprises defining a referral rule category, an appointment type class, and an intersection of the referral rule category and the appointment type class (Berman; column 4, lines 3-24, column 7, lines 23-35, 44-49).

The motivations for combining the respective teachings of Burks, Campbell, Holloway and Berman are as given in the rejections of claims 1 and 9 above, and incorporated herein.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burks et al., U.S. Patent Number 6, 453, 297, Campbell et al., U.S. Patent Number 6, 047, 259, and Holloway et al., U.S. Patent Number 5, 253, 164, as applied to claims 1 and 2 above, and further in view of Ilsen et al., U.S. Patent Number 6, 757, 898.

(A) As per claim 12, Burks, Campbell and Holloway teach a method as analyzed and discussed in claims 1 and 2 above.

Although Burks, Campbell and Holloway teach performing tasks associated with an event such as a patient visit (Burks; column 6, lines 8-19),

Burks and Campbell fail to explicitly disclose a method wherein the workflow tasks in the patient workflow performed during the event further comprise at least one of performing check-in tasks, performing check-out tasks, or any combination thereof.

However, the above features are well-known in the art, as evidenced by Ilsen.

In particular, Ilsen teaches

wherein the tasks performed during the event further comprise at least one of performing check-in tasks, performing check-out tasks, or any combination thereof (Ilsen; column 13, lines 22-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Burks and Campbell to include these limitations, as taught by Ilsen, with the motivations of restoring communications between doctors and their patients, for enhancing service to patients, and for expanding the capacity of the medical practice, without additional work by the doctor or his/her staff (Ilsen; column 3, lines 62-66).

(10) Response to Argument

In the Appeal Brief filed 4 August 2008, Appellant makes the following arguments:

**A. The Rejection of Amended Claims 1, 15, 20, 27, 28 under 35 U.S.C. § 112,
First Paragraph**

**B. The Rejection of Amended Claims 1-6, 13-16, 18-20, 24-28, 30-33 under 35
U.S.C. 103(a)**

Claims 1-6, 13-14, 20, 24-26, 28, 30-33

1. Holloway, in combination with Burks and Campbell, do not teach or suggest every limitation of Claim 1.

2. The Examiner's combination of Holloway in combination with Burks and Campbell is improper because the combination does not yield claim 1 as a predictable result.

3. The combination of Holloway, with Burks and Campbell is improper because, taken as a whole, there is no teaching, suggestion, or motivation to combine the references.

Claims 15-16, 18-19

Claim 27

C. The Rejection of Claims 9-11 under 35 U.S.C. 103(a)

D. The Rejection of Claim 12 under 35 U.S.C. 103(a)

Examiner will address Appellant's arguments in sequence as they appear in the brief.

**A. The Rejection of Amended Claims 1, 15, 20, 27, 28 under 35 U.S.C. § 112,
First Paragraph**

At pages 20-24 of the Appeal Brief, Appellant argues the rejections of claims 1, 15, 20, 27, 28 under 35 U.S.C. § 112, first paragraph. Appellant's arguments are persuasive, and accordingly the rejections of claims 1, 15, 20, 27, 28 under 35 U.S.C. § 112, first paragraph have been withdrawn.

**B. The Rejection of Amended Claims 1-6, 13-16, 18-20, 24-28, 30-33 under 35
U.S.C. 103(a)**

Claims 1-6, 13-14, 20, 24-26, 28, 30-33

There is no specific argument under this heading, but rather a discussion of a subset of the art applied by Examiner; the subject matter is discussed below.

1. Holloway, in combination with Burks and Campbell, do not teach or suggest every limitation of Claim 1.

At pages 26-30 of the Appeal Brief, Appellant argues that the limitations of claim 1 are not taught or suggested by the applied references. In response, all of the limitations which Appellant disputes are missing in the applied references have been fully addressed by the Examiner as being obvious in view of the teachings of Burks, Campbell, Holloway, Berman, and Ilsen, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Appeal Brief and in the prior Office Action (paper number 20080221), and incorporated herein. In particular, Examiner notes that the features of “automatically and repeatedly interacting with the insurance claim to correct an error by applying a new rule, an updated rule, or both received from the payor server; and (k) automatically and repeatedly updating the one or more insurance rules in the insurance company rules database that apply to the payor server by applying the new rule, the updated rule, or both received from the payor server,” as recited in claim 1, are taught by the combination of applied references.

In particular, Examiner notes that the Burks reference teaches a method and system including “the capability of receiving data messages which include adjudicated claim and remittance information from the computer stations at the insurance carriers [reads on “payor server[s]”]” (Burks; column 4, lines 7-11) and a “system 18 ... [that] ... bidirectionally communicate[s] with the trading partners ... [and] ... permits the medical transaction system 18

to receive data messages in the format specified for each trading partner and in accordance with the communication protocol for that trading partner. The data messages from the trading partners to the medical transaction system 18 include remittance and **claim adjudication information from payors** ...) (emphasis added) (Burks; column 7, lines 19-33). Burks also includes software that identifies errors in insurance claims. For example, Burks teaches “[a]dditionally, the medical transaction system of FIG. 2 includes a verifier to verify the type of data within the data fields of the data messages received from the healthcare provider computer stations. This verification preferably includes confirming whether the type of data within a data field of the received message is correct. For example, the verifier may check whether the data in a particular data field is character or numeric data. Other simplistic verification of the data that does not require historical information is also contemplated. For example, the verifier may determine that a hysterectomy for a male patient is an erroneous claim” (emphasis added) (Burks; column 6, lines 37-48).

Furthermore, Examiner notes that the Holloway reference teaches “a set of decision-making rules coupled to a knowledge base of facts and observations to assist the medical claims processor ... [and includes] ... a knowledge base and a knowledge base interpreter which applies the knowledge base using the rules specified in the knowledge base interpreter. The process is an ongoing process which can be updated [with updated rules] as new methods of inappropriate coding [i.e. “errors”] are discovered” (emphasis added) (Holloway; column 3, lines 30-35) and “[t]he computer program invokes a rule which has been specified that states that

if code 44140 appears with another code in a particular range, which in this example includes 49000, the second code should be rejected [correcting an error] and only the first specified paid. The claims processor then rejects the payment code 49000, authorizes payment for code 44140 ... [...] ...” (emphasis added) (Holloway; column 3, lines 57-64) and “[a] history database 7 is provided to update and refine the knowledge base interpreter 5 and the knowledge base 6” (emphasis added) (Holloway; column 4, line 67 to column 5, line 3) and “the PROCESS database 17 is appended to the HISTORY database 40 for recordkeeping purposes and for future use as a means to study these “case histories” and refine, update and change the rules and the knowledge base Interpreter” (Holloway; column 10, lines 3-7) and “a programmed computer system and a method of programming a computer system so that a knowledge base interpreter and a set of rules may facilitate the classification and authorization of payment [from payors] to health care providers. Since the invention resides in a programmed computer of the automatic programming category, the development of this HISTORY database 40 may lead to the development of new rules and a growth and refinement of the knowledge base interpreter 5” (emphasis added) (Holloway; column 10, lines 51-60). Examiner interprets these teachings to teach a form of “automatically and repeatedly interacting with the insurance claim to correct an error by applying a new rule, an updated rule, or both received from the payor server” and “automatically and repeatedly updating the one or more insurance rules in the insurance company rules database that apply to the payor server by applying the new rule, the updated rule, or both received from the payor server.”

Furthermore, although the Burks reference does not use the terminology “rule” the invention is clearly using rules since it contains software (“a verifier to verify the type of data within the data fields ... [...] ... includes confirming whether the type of data within a data field ... [...] ... is correct ... [...] ... the verifier may check whether the data in a particular data field is character or numeric data”) that makes the determination (i.e. compares the data to “rules”) as to whether or not an insurance claim contains erroneous data. And Examiner notes that Holloway teaches “a set of decision-making rules coupled to a knowledge base of facts and observations to assist the medical claims processor ... [and includes] ... a knowledge base and a knowledge base interpreter which applies the knowledge base using the rules specified in the knowledge base interpreter. The process is an ongoing process which can be updated [with updated rules] as new methods of inappropriate coding [i.e. “errors”] are discovered” (emphasis added) (Holloway; column 3, lines 30-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the medical transaction/ error-flagging system of Burks, an ongoing process in which the rules can be updated as new methods of inappropriate coding [i.e. “errors”] are discovered and in which the updated rules are applied, as taught by Holloway, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per Appellant's arguments in pages 26-27 of the Appeal Brief that the Burks reference "does not update the claim or the insurance rule" and "[a]ccordingly, Burks does not teach automatically and repeatedly updating the one or more insurance rules" as recited in claim 1, and Appellant's arguments in pages 27-28 of the Appeal Brief that the Campbell reference "does not teach automatically and repeatedly interacting with the insurance claim to correct an error" as recited in claim 1, Examiner respectfully notes that it was the *neither Burks nor Campbell*, but the Holloway reference that was applied to teach these limitations.

As per Appellant's arguments in the paragraph bridging pages 28-29 of the Appeal Brief that "Holloway does not teach or suggest *correcting an error in the insurance claim* as claimed in the present application" Examiner respectfully disagrees. Examiner notes that Holloway teaches "[a]n example is the inclusion of ... [...] ... a physician or his or her billing company may submit a claim for payment for two procedures ... [...] ... [t]he computer program invokes a rule which has been specified that states that if code 44140 appears with another code in a particular range, which in this example includes 49000, the second code should be rejected [correcting an error] and only the first specified paid. The claims processor then rejects the payment code 49000, authorizes payment for code 44140 ... [...] ... Without such a program, the claims processor usually pays both code numbers" (emphasis added) (Holloway; column 3, lines 45-67); Examiner interprets these teachings as a form of "correcting an error in the insurance claim."

As per Appellant's arguments in paragraphs 1-2 on page 29 of the Appeal Brief that "Holloway does not teach or suggest *automatically and repeatedly* interacting *with the insurance claim*" and that "Holloway does not teach or suggest *automatically and repeatedly* updating the *one or more insurance rules* in the insurance company rules database that *apply to the payor server* by applying the new rule, the updated rule, or both *received from the payor server*" Examiner respectfully notes that these arguments have been discussed earlier in this Examiner's Answer.

As per Appellant's arguments in paragraph 1 on page 30 of the Appeal Brief that "Holloway does not teach or suggest that the new rule, updated rule, or both are ... [...] ... stored in a set of insurance rules that apply to the payor server," Examiner respectfully notes that **this is not a claimed limitation.**

As per Appellant's arguments in paragraph 1 on page 30 of the Appeal Brief that in the Holloway reference "the new or updated rules are not received from a payor server," Examiner respectfully notes that these arguments have been discussed earlier in this Examiner's Answer.

At pages 26-30 of the Appeal Brief, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be

bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

2. The Examiner's combination of Holloway in combination with Burks and Campbell is improper because the combination does not yield claim 1 as a predictable result.

At pages 30-33 of the Appeal Brief Appellant argues that the combination of applied references does not yield Appellant's invention as a predictable result. Examiner respectfully disagrees.

Examiner notes that "Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). See also *KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the

inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467. Further, in *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test.

In particular, the Supreme Court emphasized that the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S. Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12, 148 USPQ 459, 464 (1966), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained: When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Id.* at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to

their established functions.” *Id.* In the instant application, Examiner interprets this *not* to be the case, i.e. the improvement is *not* more than the predictable use of prior art elements according to their established functions.

On pages 30-31 of the Appeal Brief, Appellant notes, reaffirming the Supreme Court, that one rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention (*KSR*, 550 U.S. at __, __, 82 USPQ2d at 1395, 1396 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62–63, 163 USPQ 673, 675 (1969); *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950)).

On pages 31-32 Appellant subsequently argues that the individual references applied to reject claim 1 do not teach limitations (j) and (k) of claim 1. These arguments have been addressed earlier in this Examiner’s Answer.

In paragraph 2 on page 32 of the Appeal Brief Appellant argues that one skilled the art could not have combined the elements ... [...] ... without changing the elements’ respective functions.” Examiner respectfully disagrees, and provides rationale below.

In particular, Examiner notes that the Burks reference teaches a method and system including “the capability of receiving data messages which include adjudicated claim and remittance information from the computer stations at the insurance carriers [reads on “payor server[s]”]” (Burks; column 4, lines 7-11) and a “system 18 ... [that] ... bidirectionally communicate[s] with the trading partners ... [and] ... permits the medical transaction system 18 to receive data messages in the format specified for each trading partner and in accordance with the communication protocol for that trading partner. The data messages from the trading partners to the medical transaction system 18 include remittance and claim adjudication information from payors ...”) (emphasis added) (Burks; column 7, lines 19-33). Burks also includes software that identifies errors in insurance claims. For example, Burks teaches “[a]dditionally, the medical transaction system of FIG. 2 includes a verifier to verify the type of data within the data fields of the data messages received from the healthcare provider computer stations. This verification preferably includes confirming whether the type of data within a data field of the received message is correct. For example, the verifier may check whether the data in a particular data field is character or numeric data. Other simplistic verification of the data that does not require historical information is also contemplated. For example, the verifier may determine that a hysterectomy for a male patient is an erroneous claim” (emphasis added) (Burks; column 6, lines 37-48).

Additionally, Examiner notes that the Campbell reference teaches “[t]he server automatically adds service items completed during the visit to the client’s invoice” (Campbell; column 15, lines 48-51) which Examiner has interpreted to be a form of correcting a deficiency

during a billing workflow task by applying one or more rules within a set of rules in a rules engine and Campbell teaches “[t]he server removes the diagnosis from the rule out list, adds it to the tentative diagnosis, and determines which abnormal observations are linked to the diagnosis” (Campbell; column 17, lines 10-12) which Examiner has interpreted to be a form of correcting a deficiency during a patient workflow task by applying one or more rules within a set of rules in a rules engine and automatically and repeatedly interacting with the information associated with the event during the patient workflow tasks and billing workflow tasks to correct an error, a deficiency, or any combination thereof by applying one or more rules within a set of rules in a rules engine (Campbell; column 2, lines 31-37, column 15, lines 48-51, column 18, lines 10-16, 27-43).

Furthermore, Examiner notes that the Holloway reference teaches “a set of decision-making rules coupled to a knowledge base of facts and observations to assist the medical claims processor ... [and includes] ... a knowledge base and a knowledge base interpreter which applies the knowledge base using the rules specified in the knowledge base interpreter. The process is an ongoing process which can be updated [with updated rules] as new methods of inappropriate coding [i.e. “errors”] are discovered” (emphasis added) (Holloway; column 3, lines 30-35); and the Holloway reference teaches “[t]he computer program invokes a rule which has been specified that states that if code 44140 appears with another code in a particular range, which in this example includes 49000, the second code should be rejected [correcting an error] and only the first specified paid. The claims processor then rejects the payment code 49000, authorizes payment for code 44140 ... [...] ...” (emphasis added) (Holloway; column 3, lines 57-

64); and the Holloway reference teaches “[a] history database 7 is provided to update and refine the knowledge base interpreter 5 and the knowledge base 6” (emphasis added) (Holloway; column 4, line 67 to column 5, line 3) and “the PROCESS database 17 is appended to the HISTORY database 40 for recordkeeping purposes and for future use as a means to study these “case histories” and refine, update and change the rules and the knowledge base Interpreter” (Holloway; column 10, lines 3-7) and “a programmed computer system and a method of programming a computer system so that a knowledge base interpreter and a set of rules may facilitate the classification and authorization of payment [from payors] to health care providers. Since the invention resides in a programmed computer of the automatic programming category, the development of this HISTORY database 40 may lead to the development of new rules and a growth and refinement of the knowledge base interpreter 5” (emphasis added) (Holloway; column 10, lines 51-60). Examiner interprets these teachings to teach a form of “automatically and repeatedly interacting with the insurance claim to correct an error by applying a new rule, an updated rule, or both received from the payor server” and “automatically and repeatedly updating the one or more insurance rules in the insurance company rules database that apply to the payor server by applying the new rule, the updated rule, or both received from the payor server.”

Furthermore, although neither the Burks reference nor the Campbell reference uses the terminology “rule” the Burks invention is clearly using rules since it contains software (“a verifier to verify the type of data within the data fields ... [...] ... includes confirming whether the type of data within a data field ... [...] ... is correct ... [...] ... the verifier may check whether the data in a particular data field is character or numeric data”) that makes the determination (i.e.

compares the data to “rules”) as to whether or not an insurance claim contains erroneous data. And the Campbell invention is clearly using rules since it contains “server software ... [that] ... coordinates communication among the client computers, manages a database of client and patient data, monitors data supplied via the client computers, performs data processing functions on the data as observations are made, and dynamically updates the display data displayed on the client computer” (Campbell; column 2, lines 54-59) and that “checks clients and patients in and out of the office and handles billing functions” (Campbell; column 5, lines 45-57) and wherein “[t]he central computer 220 also controls administrative and billing functions ... [and is] ... responsible for handling billing of clients that have selected wellness plans” (Campbell; column 7, lines 9-15).

Moreover, Examiner notes that Holloway explicitly teaches “a set of decision-making rules coupled to a knowledge base of facts and observations to assist the medical claims processor ... [and includes] ... a knowledge base and a knowledge base interpreter which applies the knowledge base using the rules specified in the knowledge base interpreter. The process is an ongoing process which can be updated [with updated rules] as new methods of inappropriate coding [i.e. “errors”] are discovered” (emphasis added) (Holloway; column 3, lines 30-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the medical transaction/ error-flagging system of Burks, an ongoing process in which the rules can be updated as new methods of inappropriate coding [i.e. “errors”] are

discovered and in which the updated rules are applied, as taught by Holloway, and a medical office management system that manages both patient and billing workflow, automatically generates information, provides cost estimates, tracks the conducting of a physical examination, and checks clients and patients in and out of the office and handles billing functions, as taught by Campbell, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

At the paragraph bridging pages 32-22 of the Appeal Brief Appellant argues that even if the Burks, Campbell, and Holloway references were combined “the system would fail to achieve ... [...] ... correcting errors in a claim before submission to the insurance company ... [...] ...” Examiner respectfully notes that **this is not a claimed limitation**.

3. The combination of Holloway, with Burks and Campbell is improper because, taken as a whole, there is no teaching, suggestion, or motivation to combine the references.

At pages 33-37 of the Appeal Brief Appellant asserts that the applied references “do not teach all of the steps claimed by appellant,” and disagrees with the motivations to combine the references. Examiner respectfully notes that these arguments have been discussed earlier in this Examiner’s Answer.

As per Appellant's arguments in lines 1-2 on page 34 of the Appeal Brief that "Burks teaches away from a system that requires a centralized database for validating ... [...] ... "

Examiner respectfully notes that **this is not a claimed limitation**.

As per Appellant's arguments in the paragraph bridging pages 35-36 page 35 of the Appeal Brief that there is no motivation to combine the Burks, Campbell, and Holloway references because they differ in the nature of the problem to be solved, Examiner respectfully disagrees. Examiner notes that for purposes of 35 U.S.C. 103, prior art can be either in the field of applicant's endeavor or be reasonably pertinent to the particular problem with which the applicant was concerned. Furthermore, prior art that is in a field of endeavor other than that of the applicant, (as noted by the Court in KSR, "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a *different one*." (Emphasis added) 550 U.S. at __, 82 USPQ2d at 1396) or solves a problem which is different from that which the applicant was trying to solve, may also be considered for the purposes of 35 U.S.C. 103. (The Court in KSR stated that "[t]he first error * * * in this case was * * * holding that courts and patent examiners should look only to the problem the patentee was trying to solve ... [...] ... The second error [was] * * * that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem." 550 U.S. at __, 82 USPQ2d at 1397.) Examiner further notes that the rationale for combining references has been discussed earlier in this Examiner's Answer.

As per Appellant's arguments in the last two lines in paragraph 1 on page 36 of the Appeal Brief that "Holloway merely applies the rules and rejects the claim if an error is detected," Examiner respectfully disagrees. Examiner herein repeats the earlier discussion, that Holloway teaches "[t]he computer program invokes a rule which has been specified that states that if code 44140 appears with another code in a particular range, which in this example includes 49000, the second code should be rejected [correcting an error] and only the first specified [code is] paid. The claims processor then rejects the payment code 49000, authorizes payment for code 44140... [...] ..." (emphasis added) (Holloway; column 3, lines 57-64). In other words, in the Holloway reference, it is the *erroneous code that is rejected* but the claim is paid (i.e. the claim is corrected).

At pages 36-37 of the Appeal Brief Appellant argues issues previously discussed in this Examiner's Answer.

Claims 15-16, 18-19

There is no specific argument under this heading; the subject matter is discussed above.

Claim 27

There is no specific argument under this heading; the subject matter is discussed above.

C. The Rejection of Claims 9-11 under 35 U.S.C. 103(a)

At pages 38-39 of the Appeal Brief Appellant argues issues previously discussed in this Examiner's Answer.

As per Appellant's arguments in paragraph 2 on page 39 of the Appeal Brief that the Berman reference does not teach "the limitations as discussed above with reference to claim 1, namely steps (i) through (k)," Examiner respectfully notes that it was *not the Berman reference*, but the combined teachings of Burks, Campbell and Holloway that was applied to teach these limitations.

D. The Rejection of Claim 12 under 35 U.S.C. 103(a)

At pages 40-41 of the Appeal Brief Appellant argues issues previously discussed in this Examiner's Answer.

As per Appellant's arguments in paragraph 2 on page 41 of the Appeal Brief that the Ilsen reference does not teach "the limitations as discussed above with reference to claim 1, namely steps (i) through (k)," Examiner respectfully notes that it was *not the Ilsen reference*, but the combined teachings of Burks, Campbell and Holloway that was applied to teach these limitations.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

Appellant's arguments at pages 20-41 of the Appeal Brief filed August 4, 2008 do not appear to persuasively require a withdrawal of the Examiner's grounds of rejection. As specified in the remarks and rebuttals given above, Appellant's arguments apparently fail to appreciate the clear and unmistakable suggestions provided in the prior art of record, and relied upon by the Examiner for motivation to combine such well-known elements of the prior art. As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Examiner's Answer as well as the previous Office Action (Paper Number 20080221), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of

rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Respectfully submitted,

Natalie A. Pass

Examiner, Art Unit 3686

/N. A. P./

October 21, 2008

/Gerald J. O'Connor/
Supervisory Patent Examiner

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Group Art Unit 3686

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

GERALD O'CONNOR /GJOC/
Supervisory Patent Examiner
Tech Center 3600

VINCENT MILLIN /VM/
Appeals Specialist
Tech Center 3600